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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/547,996	11/23/2005	Anders Hallberg	3951.1000-000	8210
21005 7590 06/06/2008 HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133				
EXAMINER				
LOEWY, SUN JAE Y				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
06/06/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/547,996

Applicant(s)

HALLBERG ET AL.

Examiner

SUN JAE Y. LOEWE

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42, 44 and 46-53 is/are pending in the application.
- 4a) Of the above claim(s) 46-49 and 53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42, 44 and 50-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

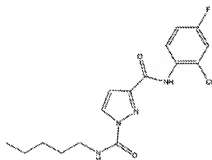
- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/003)  
Paper No(s)/Mail Date 11-23-2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-42, 44 and 46-53 are pending in the instant application.

#### *Election/Restrictions*

2. Applicant's election of Group I, and species of Example 66 (structure below), in the reply filed on April 7, 2008 is acknowledged.



Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The restriction requirement between Groups I and II is hereby made FINAL.

3. Pursuant MPEP 1893.03

#### *“(Excerpts)”*

Once the national stage application has been taken up by the examiner, prosecution proceeds in the same manner as for a domestic application with the exceptions that:

(A) the international filing date >>(or, if appropriate, the priority date)< is the date to keep in mind when searching the prior art, and

(B) unity of invention proceeds as under 37 CFR 1.475.

.....

¶ 18.20 National Stage Election of Species in 35 U.S.C.

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*371 Applications*

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

[1]

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

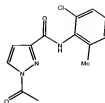
Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a). ”

the search and examination detailed in this office action was performed following the guidelines provided by MPEP 803.02

*“(Excerpts)”*

Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable \*\*, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration.”



The elected compound, and the non-elected species of CC1=CN(C(=O)Nc2cc(Cl)c(C)cc2)C=C1 (R1=substituted

phenyl; R2=H; Y=CO; X=bond; R3=methyl), were not allowable. Therefore, the provisional

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election of species was given effect and non-elected species were withdrawn from further consideration.

4. Claims 46-49 and 53 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected subject matter. Election was made **without** traverse in the reply filed on April 7, 2008.

***Priority***

5. Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on an application filed in Sweden on March 14, 2003. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of any foreign application. A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

***Information Disclosure Statement***

6. The information disclosure statement (IDS) dated November 23, 2005 was filed in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. The IDS was considered. A signed copy of form 1449 is enclosed herewith.

***Claim Objections***

7. Claims 1-42, 44 and 50-52 objected to for containing non-elected subject matter. Currently, non-elected subject matter comprises all compounds of formula I that are not the elected species of Example 66.

8. Claim 37 objected to because of the following informality. The claim refers to "eholor," which appears to be a typographical error. Appropriate correction is requested.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

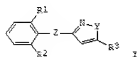
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 1-41, 44 and 50-52 rejected under 35 U.S.C. 103(a) as being obvious over Lepage et al. (caplus AN 1992:128914).

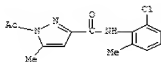
Determination of the scope and contents of prior art.

The reference teaches the following compounds as anticonvulsants



{I: R<sub>1</sub> = alkyl; R<sub>2</sub> = alkyl, halo; R<sub>3</sub> = H, (halo)alkyl, alkoxy, CN, etc.; Y = O, S, NR<sub>4</sub>; R<sub>4</sub> = H, alkyl, PhCH<sub>2</sub>, etc.; Z = CONR<sub>6</sub>, NR<sub>6</sub>CO, HNC(=O)CH; R<sub>6</sub> = alkyl}

The reference further teaches the following preferred embodiment:



Ascertaining the differences between prior art and instant claims.

The following modification to the prior art compound (ie. preferred embodiment above) results in the instant non-elected species: replace hydrogen for methyl at the 5 position of the pyrazole ring. Thus, the prior art compound is the next lower homolog of the instant non-elected species.

Resolving the level of ordinary skill in the pertinent art – Prima Facie Case of Obviousness.

To those skilled in chemical art, one homologue is not an advance over an adjacent member of a homologous series. The reason for this is that one of ordinary skill, knowing the properties of one member of series, would know what properties to expect in adjacent members. In re Henze, 85 USPQ 261 (1950). In re Wood, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and In re Lohr, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963).

One of ordinary skill would be motivated, from the prior art disclosure – ie. generic teaching and the preferred embodiment - to make the modification required to arrive at the instant invention with reasonable expectation of success for obtaining an additional compound for the same utility. The motivation would be to make an additional anticonvulsant materials.

Thus, the instant claims are *prima facie* obvious over the teaching of the prior art.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.



Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-42, 44 and 50-52 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21, 23 and 29-31 of U.S. Appl. 11/663,180. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons below.

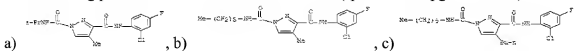
This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Determination of the scope and contents of claims 1-21, 23 and 29-31 of US Appl. 11/663,180  
The claims are drawn to a Markush group of compounds



that are useful in the treatment of inflammation. Variable R<sup>3</sup> is generically taught to be C1-8 alkyl. Variable R<sup>4</sup> is generically taught to be H, halo or C1-6 alkyl.

The following preferred embodiments are disclosed (specification pg. 49 and 50):



Ascertaining the differences between claims 1-21, 23 and 29-31 of US Appl. 11/663,180 and the claims at issue.

The following modification to prior art compound b) results in the instant elected species: decrease the amide alkyl chain from C6 to C5 and replace H for methyl at the 4-position of the pyrazole ring.

Resolving the level of ordinary skill in the pertinent art – Prima Facie Case of Obviousness.

MPEP § 2144.08.II.A.4(c) states "...consider teachings of a preferred species within the genus. If such a species is structurally similar to that claimed, its disclosure may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties". This is a "Genus-Species Guidelines" for the examination based on 35 U.S.C. 103. An analogous guideline was followed here for the analysis of obviousness-type double patenting.

To those skilled in chemical art, one homologue is not an advance over an adjacent member of a homologous series. The reason for this is that one of ordinary skill, knowing the properties of one member of series, would know what properties to expect in adjacent members. In re Henze, 85 USPQ 261 (1950). In re Wood, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and In re Lohr, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963).

One of ordinary skill would be motivated to make the instant elected species, which is a homolog of preferred embodiment b) with reasonable expectation of success for obtaining an additional compound for the same utility. The motivation would be to make an additional compounds for the treatment of inflammation.

The preferred embodiments and generic teaching suggests to one of ordinary skill to practice the instantly claimed invention. Thus, the instant claims are *prima facie* obvious over claims 1-21, 23 and 29-31 of US Appl. 11/663,180.

### ***Conclusion***

11. No claims allowed.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sun Jae Y. Loewe whose telephone number is (571) 272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sun Jae Y. Loewe, Ph.D./  
6-3-2008

/Kamal A Saeed, Ph.D./  
Primary Examiner, Art Unit 1626